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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/560,239	12/12/2005	Kazuhiro Yoshino	1422-0703PUS1	1480
2292 7590 07/21/2009 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
WIEST, PHILIP R				
ART UNIT		PAPER NUMBER		
3761				
NOTIFICATION DATE		DELIVERY MODE		
07/21/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/560,239

Applicant(s)

YOSHINO ET AL.

Examiner

Philip R. Wiest

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 6/12/09.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Suspension of Action

1. The final rejection mailed 5/26/09 was issued in error, as it was issued during the requested 3-month suspension of action. The final rejection mailed 5/26/09 has therefore been vacated. For the purposes of the instant rejection, the examiner has relied upon applicant's arguments mailed 6/12/09 (which encompass the arguments mailed 3/13/09 as well as new arguments with regard to the declaration by Tomoki Kawakita).

Claim Rejections - 35 USC § 102 / Claim Rejections - 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wada et al. (US 6,150,582).
3. With respect to Claims 1-4, Wada et al. (hereafter Wada) discloses an absorbent article comprising an absorbent layer that is made of a water-absorbent resin (i.e.

hydrolysates of starch-acrylonitrile graft polymers or crosslinked polymers of acrylic acid salt) and a hydrophilic fiber (i.e. mechanical pulp). Wada teaches that the absorbent comprises about 50% water-absorbent resin by weight (Column 4, Line 57 through Column 5, Line 20). Because Wada's absorbent materials are identical and supplied within an overlapping weight ratio range as disclosed in applicant's specification (5-60% weight water-absorbent resin), the absorbent material of Wada inherently has a water absorption of physiological saline of 60-100 g/g and a water retaining capacity of physiological saline of 45-80 g/g, wherein the water absorption rating is at least 15 g/g higher than the water retaining capacity rating. Additionally, because the materials are the same, the absorbent inherently has the same water absorption rates and vortex time disclosed by applicant in claims 2-4.

In the alternative, it is the position of the Examiner that Wada reasonably suggests the limitations claimed by Applicant. It has been held that when the claimed compositions are not novel, they are not rendered patentable by recitation of properties, whether or not these properties are shown or suggested in prior art. See *In re Fitzgerald* or *In re Spada*, 911 F 2d 705, 709 15 USPQ 1655, 1658 (Fed. Cir. 1990). In other words, two same compounds cannot have mutually exclusive properties and, since the compounds of Wada are identical to those as instantly claimed, they would necessarily exhibit the same properties claimed by Applicant.

4. With respect to Claim 5, Wada disclose that the absorbent layer is disposed as part of an absorbent article, wherein the absorbent layer is interposed between a liquid-permeable sheet and a liquid-impermeable sheet (Column 23, Lines 1-9).

Response to Arguments

5. In the arguments filed 6/12/09, applicant requested that the affidavit filed 6/12/08 be reconsidered. Applicant argues that Wada does not teach or reasonably suggest the claimed invention. The affidavit under 37 CFR 1.132 filed 6/12/08 is insufficient to overcome the rejection of claims 1-5 based upon 35 U.S.C. 102(b) and 103(a) as set forth in the last Office action because: the affidavit is drawn to specific examples disclosed in the instant application and by Wada. These examples cite specific resins and crosslinking agents that are used to create said resins, and are not the only possible combinations disclosed by Wada. The data in the affidavit does not indicate that Applicant performed the reported experiments with the claimed composition. Rather, the affidavit sets forth that experiments were conducted with disclosed compositions. The affidavit, therefore, is not commensurate with the scope of the claims. The instant claims are drawn to an absorbent article comprising a water-absorbent resin and a hydrophilic fiber. As defined in applicant's specification, the content of water-absorbent resin is preferably 10-50% by weight [0017], the water-absorbent resin may be at least one of crosslinked polymers of acrylic acid salt or hydrolysates of starch-acrylonitrile copolymers [0035], and the hydrophilic fiber may include at least mechanical pulp.

6. Wada teaches a variety of material combinations that result in absorptive materials. Although Wada gives a variety of examples of absorptive materials, these examples are not the only combinations taught by Wada. Because Wada teaches the

use of mechanical pulp as a hydrophilic fiber (Column 7, Lines 19-28), crosslinked polymers of acrylic acid salt or hydrolysates of starch-acrylonitrile copolymers as a water-absorbent resin (Column 1, Lines 17-25), and a resin:fiber ratio of about 1:1 (Column 4, Line 57 through Column 5, Line 20), Wada anticipates the absorbent material *as claimed*.

7. Regarding the declaration of Tomoki Kawakita, the affidavit under 37 CFR 1.132 filed 6/12/09 is insufficient to overcome the rejection of claims 1-5 based upon 35 U.S.C. 102(b) and 103(a) as set forth in the last Office action because the affidavit is drawn to only to a *specific example* disclosed in the instant application and by Wada (Referential Example 4). The Referential Examples cite specific resins and crosslinking agents that are used to create said resins, and *are not the only possible combinations disclosed by Wada*. The affidavit sets forth that experiments were conducted to compare the composition of Referential Example 4 and the claimed device. However, because Wada's disclosure is not limited by the referential examples, the affidavit is not commensurate with the scope of the claims. The instant claims are drawn to an absorbent article comprising a water-absorbent resin and a hydrophilic fiber. As defined in applicant's specification, the content of water-absorbent resin is preferably 10-50% by weight [0017], the water-absorbent resin may be at least one of crosslinked polymers of acrylic acid salt or hydrolysates of starch-acrylonitrile copolymers [0035], and the hydrophilic fiber may include at least mechanical pulp.

8. Wada teaches a variety of material combinations that result in absorptive materials. Although Wada gives a variety of examples of absorptive materials, these examples are not the only combinations taught by Wada. Because Wada teaches the use of mechanical pulp as a hydrophilic fiber (Column 7, Lines 19-28), crosslinked polymers of acrylic acid salt or hydrolysates of starch-acrylonitrile copolymers as a water-absorbent resin (Column 1, Lines 17-25), and a resin: fiber ratio of about 1:1 (Column 4, Line 57 through Column 5, Line 20), Wada anticipates the absorbent material *as claimed*.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, THIS ACTION IS MADE FINAL even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phil Wiest whose telephone number is (571)272-3235. The examiner can normally be reached on 8:30am-5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Phil Wiest/

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Examiner, Art Unit 3761

/Tatyana Zalukaeva/

Supervisory Patent Examiner, Art Unit 3761